

## REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-16, 19, 21-34 and 36-42.

The following claims are *independent*: 10, 19, 30 and 34.

The following claims have previously been *cancelled* without prejudice or disclaimer: 17 and 18.

Please *cancel* the following claims without prejudice or disclaimer: 20 and 35.

Please *amend* claims 10, 19, 30-34 and 36-42; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

## Claim Objections

The Office Action has objected to the numbering of the claims in the previous Amendment/Response. Applicant submits that the misnumbered claims 26-40 have been

renumbered as claims 28-42 and claims 31-33 and 35-42 have been amended accordingly to reflect the corrected numbering of the claims. Accordingly, Applicant submits that the Office Action's objections to the numbering of the claims have been overcome.

### **Claim Rejections – 35 U.S.C. § 102**

The Office Action rejected claims 10-14, 16, 19, 20, 23, 24, 26-28 and 30-42 under 35 U.S.C. § 102(e) as anticipated by Dirksen et al., US Patent No. 6,853,975 (hereinafter "Dirksen").

Applicant respectfully traverses these rejections and submits that a *prima facie* showing of anticipation has not been established and that the applied reference fails to discuss or anticipate every element of each pending claim.

Amended independent claim 10 recites, *inter alia*:

A computer system implemented method for conducting an employee performance review comprising:

... gathering substantial employment related user interaction data corresponding to a relevant review period of time;  
generating and preloading a list of reviewees for the user in accordance with the gathered user interaction data;  
receiving one or more reviewee selection from the preloaded list for employment performance review ...

The Office Action asserts the previously pending elements are shown in Dirksen (col. 4, lines 40-64) and alleges:

"... based on employee relationships, it is determined who should rate whom; further the list of reviewees is preloaded since the rater must access the system and select the reviewee name from the system ... ." (Office Action, p. 5, § 8).

Applicant respectfully disagrees and traverses the Office Action's characterization of the claim language and of Dirksen as applied in the rejection of the previously pending claim elements. Applicant also disagrees with the Examiner's response to certain of Applicant's previous arguments and continues to maintain the position that the reference of record does not anticipate the previously pending or amended claim elements. Applicant submits that the Examiner appears to not be properly interpreting the claimed elements. As such, Applicant has amended the claims to provide further clarification and requests reconsideration in view thereof.

In direct contrast to the amended claimed elements, Applicant submits that Dirksen discusses *a generic rater nomination form where a user enters a rater's identification information as a way of soliciting review from the rater*. For example, Applicant notes Dirksen's Figures 12, 13 and 14 showing text boxes 106 and 108, 112 and 116 respectively where a user enters the PROF ID of the raters that wish to nominate. Similarly, in the Examiner's cited portions Dirksen discusses "PROFS IDs for these raters are entered at box 112 so that the raters can be notified by a electronic messaging system." (Dirksen, col. 4, lines 46-49). Applicant submits that such a system reliant on the user's entry of PROF IDs of the raters, does not have any concept of, anticipate or discuss the claimed "... gathering substantial employment related user interaction data corresponding to a relevant review period of time [and] generating and preloading a list of reviewees for the user in accordance with the gathered user interaction data ... ." Furthermore, since in Dirksen there is no customized list of raters for the rater, Applicant submits that claimed "... receiving one or more reviewee selection from the preloaded list for employment performance review ..." is also not anticipated or discussed.

For at least the foregoing reasons, Applicant submits that Dirksen does not anticipate or discuss the amended claimed elements. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of the claim.

Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how and specifically why the Examiner believes Dirksen discusses or anticipates the claimed "... gathering substantial employment related user interaction data corresponding to a relevant review period of time [and] generating and preloading a list of reviewees for the user in accordance with the gathered user interaction data ..." as recited in amended independent claim 10.

Although of different scope than amended independent claim 10, Applicant submits that at least the noted elements of amended independent claim 19 are also not discussed or anticipated by Dirksen. For example, amended independent claim 19 recites, *inter alia*:

A computer system implemented method for conducting employee performance reviews, comprising:  
    identifying by a computer system one or more interactions during an evaluation period between a reviewer and one or more reviewees based on overlapping projects and clients;  
    generating and preloading by the computer system a list of the reviewees related to the identified interactions for the reviewer;  
    receiving by the computer system a selection of reviewees from the preloaded list ...

Applicant submits that at least the noted claim elements in amended independent claim 19 are not discussed or anticipated by Dirksen for at least similar reasons as discussed above when identifying deficiencies in the application of Dirksen with regard to amended independent claim 10. Accordingly, Applicant requests reconsideration and withdrawal of the rejections and allowance of the claim.

Although of different scope than amended independent claims 10 and 19, Applicant submits that at least the noted elements of amended independent claim 30 are also not discussed or anticipated by Dirksen. For example, amended independent claim 30 recites, *inter alia*:

A computer system for conducting employee performance reviews, comprising:  
gather substantial employment related user interaction data corresponding to a relevant review period of time;  
generate and preload a list of reviewees for the user in accordance with the gathered user interaction data;  
receive one or more reviewee selection from the preloaded list for employment performance review ... .

Applicant submits that at least the noted claim elements in amended independent claim 30 are not discussed or anticipated by Dirksen for at least similar reasons as discussed above when identifying deficiencies in the application of Dirksen with regard to the independent claims 10 and 19. Accordingly, Applicant requests reconsideration and withdrawal of the rejections and allowance of the claim.

Although of different scope than amended independent claims 10, 19 and 30, Applicant submits that at least the noted elements of amended independent claim 34 are also not discussed or anticipated by Dirksen. For example, amended independent claim 34 recites, *inter alia*:

A computer system for conducting employee performance reviews, the system comprising:  
... identify one or more interactions during an evaluation period between a reviewer and one or more reviewees based on overlapping projects and clients;  
generate and preload a list of the reviewees related to the identified interactions for the reviewer;  
receive a selection of reviewees from the preloaded list ... .

Applicant submits that at least the noted claim elements in amended independent claim 34 are not discussed or anticipated by Dirksen for at least similar reasons as discussed above when identifying deficiencies in the application of Dirksen with regard to the independent claims 10, 19 and 30. Accordingly, Applicant requests reconsideration and withdrawal of the rejections and allowance of the claim.

Similarly, Applicant submits claims 11-14, 16, 23, 24, 26-28 and 31-33 and 36-42 are all patentable over Dirksen for at least similar reasons as discussed above when identifying deficiencies in the application of Dirksen with regard to the independent claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of the claims.

### **Claim Rejections – 35 U.S.C. § 103**

The Office Action has rejected claim 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dirksen et al., US Patent No. 6,853,975 (hereinafter “Dirksen”). The Office Action has further rejected claims 21, 22, 25 and 29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dirksen in view of Ibarra, US Patent No. 6,119,097 (hereinafter “Ibarra”). Applicant respectfully traverses these rejections and submits that the applied references, taken alone or in combination, do not discuss or render obvious the pending claim elements. Furthermore, Applicant submits that there is no motivation to combine the references.

As these claims depend directly or indirectly from independent claims 10 and 19, Applicant submits that the noted claims are also patentable over the references of record for at least similar reasons as discussed above with regard to amended independent claims 10

and 19 from which they depend. Furthermore, Applicant disagrees and traverses the Official Notice taken in this rejection. In particular, with regard to claim 15, the Examiner asserts:

... it is old and well known in the art of communication networks to allow for work to be complete while disconnected from the Internet wherein the information can be stored and communicated over a network when there is a network connection present. This feature allows for convenience to the operator wherein he or she can complete the rating while away from the office. (Office Action, pg. 8, § 8).

Applicant submits that the Examiner has to establish that the asserted elements would have been well known to "one of the ordinary skill in the art, at the time of the invention" within the context to the recited claim elements. As such Applicant submits that the Examiner has employed impermissible hindsight by merely relying on conclusionary statement that the claimed element(s) allegedly "was old and well known." Further, Applicant respectfully submits the Examiner has not defined the level of ordinary skill in the art at the time the invention was made within the context of the claimed invention, much less "cast the mind back to the time the invention was made ..., to occupy the mind of one skilled in the art" [*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)]. As such, Applicant submits that the Examiner has simply concluded that these elements are allegedly old and well known. However, Applicant submits that the Examiner has not established how the claimed element(s) would be "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the invention was made within the context of the claimed invention, as required per MPEP 2144.03(A) to establish a viable basis for Official Notice. Therefore, Applicant again respectfully traverses the Examiner's Official Notice (and any other instances

of Official Notice in the pending Office Action) and requests that the Examiner provide explicit evidentiary support asserting that the claim element(s) is allegedly unquestionably demonstrable as being old and well known as one of ordinary skill in the art at the time of the invention would understand within the context of the claimed invention.

Thus in addition to the submitted allowability of the claims as discussed above with respect to the independent claims from which they depend, Applicant submits that rejected claims are also believed to be allowable for the additional reason that Official Notice has not been properly established resulting in the rejection under 35 U.S.C. § 103 not being properly founded.

## **CONCLUSION**

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted



as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-16, 19, 21-34 and 36-42, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

### **Authorization**

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-480. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-480.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
*Attorney(s) for Applicant,*  
CHADBOURNE & PARKE LLP

Dated: September 27, 2010

By: /Walter G. Hanchuk/  
Walter G. Hanchuk  
Registration No.: 35,179

**Correspondence Address:**

CHADBOURNE & PARKE LLP  
30 Rockefeller Plaza  
New York, NY 10112

212-408-5100 (Telephone)  
212-541-5369 (Facsimile)  
patents@chadbourne.com (E-mail)